

REMARKS

The office action and the references cited and applied therein have been carefully considered together with the present patent application and minor corrections to the specification and claim 17 have been made. There have been no amendments to the claims that are related to patentability for the reason that it is believed that the rejections are improper, contrary to established legal precedent of the CCPA as well as the Court of Appeals for the Federal Circuit, and should be withdrawn.

More particularly, claims 1-2, 5-6, 12-14 and 16 have been rejected under 35 U.S.C. 102(a) as being anticipated by the Smith application which is a continuation of patent 6,427,070, also of record but not applied. Neither of these references are believed to anticipate, teach or suggest these rejected claims and it is respectfully requested that the rejection be withdrawn and the claims passed to issue.

This rejection is improper because it is contrary to the established law of inherency in a 102(a) anticipation. The examiner states in the discussion of this rejection that “however, Smith fail to is silent about the specific of relay coil.” While this sentence is grammatically flawed, it is believed to mean that Smith fails to show or describe the specifics of the relay coil, or that Smith is silent about the specifics of the relay coil. The examiner then states that “Smith did disclose of the relay monitoring the presence of AC power being applied to said audio unit and causing said relay to open circuit and isolate said audio unit from said battery when AC power is applied to said audio unit in closed circuit when AC power is not applied to said audio unit, thereby enabling said battery pack to power said audio unit when AC power is not applied thereto.”

This described operation is stated to be supported by paragraph 0031, but it is not -

- not even close. With all due respect, it is exceedingly disappointing that such a preposterous description of the operation of Smith can be asserted by the examiner. It exhibits either cavalier treatment of the actual text of this paragraph, if not intellectual dishonesty. **Nothing** in paragraph 0031 even remotely discloses relay monitoring of the presence of AC power being applied to said audio unit. **Nothing** in this paragraph discloses relay monitoring which causes said relay to open circuit and isolate said audio unit from said battery when AC power supplied to said audio unit in a closed circuit when AC power is not applied to said audio unit.

Paragraph 0031 describes a much different operation and is set out below, (with text in bold being made for emphasis):

Power supply 40 also provides power to radio circuitry 44. A **switching means 42 may be connected to switch knob 17 to properly select the components receiving power.** For example, the **user can select** if the power supply 40:

- (a) provides power to both the radio circuitry 44 and to charger 43 (for charging battery pack 60);
- (b) provides power to the radio circuitry 44 from the battery pack 60;
- (c) provides no power to any component; etc.

Switching means 42 may comprise relays, transistors or other switching devices as is well known in the art. Preferably power supply

40 can accept power from battery packs having different voltages.

Paragraph 0031 describes the operation of the Smith device which is not believed to be contradicted by any other part of the patent. It clearly discloses and describes a switching means 42 that may be connected to a switch knob 17 to properly **select** the components receiving power. The knob 17 controls the switching means 42 which is described in the next to last sentence of the paragraph that it may comprise relays, transistors or other switching devices as is well known in the art.

The switching means is necessarily a means plus function element and it is defined in that sentence to comprises relays, transistors or other switching devices. However, the switching means performs the **function** that is clearly delineated in three paragraphs (a), (b) and (c). More particularly, the user can **select** if the power supply is to (a) provide power to both the radio circuitry 44 and to charger 43 (for charging battery pack 60), or (b) provides power to the radio circuitry 44 from the battery pack 60, or (c) provides no power to any component; etc.

None of these three alternatives is automatically done. It is stated to be selected by the user. There is no description whatsoever that indicates that there is any automatic operation from one option to another based upon a relay coil. To contend that this paragraph does grossly mischaracterizes the clear description of the operation of the Smith device. With the described operation in paragraph 0031, there is no need whatsoever for monitoring the presence of AC power being applied to the audio unit and such monitoring is not remotely described in the Smith patent. Therefore, the examiner's assertion that it is inherent that there must exist such a "coil in relay" for doing the

monitoring is not only factually incorrect but is illogical.

There is controlling legal precedent that defines the requirements for inherency and those requirements are clearly not met by Smith. In *Continental Can Co. USA, Inc. v. Monsanto Co.* 948 F.2d 1264, 1269 (Fed. Cir. 1991) the court stated.

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. [Citations omitted.] If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

This has been established law since *In re Oelrich* 666 F.2d 578 (CCPA 1981) which is one of the ‘citations omitted’ in the text quoted above.

With these requirements, it is clear that using inherency as a basis for the 102(a) rejection is improper. The examiner’s reliance on Smith is also misplaced, because even if Smith were to use a relay as its switching means, it does not anticipate, teach or suggest a relay coil connected in circuit between said cord and said audio unit, said coil monitoring the presence of AC power being applied to said audio unit and causing said relay to open circuit and isolate said audio unit from said battery when AC power is applied to said audio unit and close circuit when AC power is not applied to said audio unit, thereby enabling said battery pack to power said audio unit when AC power is not applied thereto. Smith clearly describes a switching means that can alternatively provide

power to both the radio circuitry and the charger, or provide power to the radio circuitry from the battery pack, or provide no power to any component. These alternatives are chosen, i.e., selected, by the user. There is no anticipation, teaching or suggestion of a relay coil operating as described in the final paragraph of claim 1.

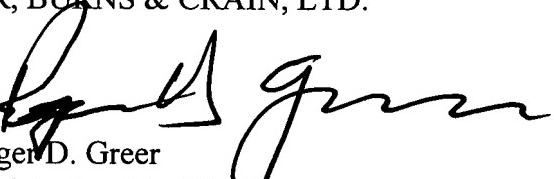
The examiner has rejected claim 17, along with claims 7-11 and 18-21 under 35 U.S.C. 103(a) as being unpatentable over Smith and further in view of Kelly. In the discussion of the rejection, the examiner misstates the claim language of claim 17 by characterizing it as “a cord and plug for connecting said apparatus to a source of AC power and a first circuit for connecting said cord to said charger and said audio unit, whereby AC power is not applied to said audio unit” and then states that Smith meets that claim except for the further limitation of the housing which is supplied by Kelly. Claim 17 actually has a final paragraph that reads “a circuit for connecting said cord to said charger and said audio unit, whereby AC power is applied to said audio unit to power the same and AC power is also applied to said charger, said circuit isolating said audio unit from said battery pack when AC power is applied to said audio unit and connecting said battery pack to power said audio unit when AC power is not applied to said audio unit.” This describes the automatic operation of the circuit, which for the same reasons discussed with respect to claim 1, is not taught or suggested by either paragraphs 0030 or 0031. Since Smith has a gaping deficiency that is not supplied by Kelly or any of the other prior art of record, this claim is also believed to be allowable and such action is respectfully requested.

All of the dependent claims necessarily incorporate the features of the independent claim from which they depend and in addition supply other features and/or functionality that is not found in those claims and therefore for this reason alone it is believed that all dependent claims are in condition for immediate allowance. For the foregoing reasons, reconsideration and allowance of all pending claims is respectfully requested.

Respectfully submitted,

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